

**Claims 25-28 Distinguish
From Miyahra et al.**

Claims 25-28 have been rejected under 102(b) as being anticipated by Miyahra et al. However, MPEP 2131 states that "a claim is anticipated only if each and every element is found, either expressly or inherently described, in a single prior art reference." Applicant submits that claims 25-28 recite elements not found in Miyahra et al.

Specifically, for example, claim 25 recites that, "during assembly, the outlet port of the receiver is placed in the opening of the insert and the receiver and insert are inserted as a unit into the open end of the hollow body portion until the outlet port engages and extends partially into the hollow elongated tubular portion." Miyahra et al. does not teach these limitations. First, during assembly, as can be seen from FIG. 1 of Miyahra et al., the insert and receiver as a unit cannot possibly be placed in the open end of the hollow body portion (i.e., "the open end of the tubular extension 12" as set forth in the Office Action) because the receiver is much larger than that opening. It simply would not fit. Second, again as can be seen from FIG. 1, the outlet port 55 (defined more clearly in FIG. 5 of Miyahra et al.) does not engage the hollow elongated tubular portion. Rather, the sound outlet port 55 engages an additional member (not labeled) located in the portion 12, and is completely flanked by material 57 which prevents the port 55 from contacting the portion 12. Third, since the sound outlet portion 55 is completely flanked by material 57 as shown in FIG. 1, the sound outlet port 55 necessarily is not placed in an opening of the material during assembly.

Claim 25 is therefore novel.

Similarly, claim 26 recites, for example, that the sound outlet port mates with the hollow elongated tubular portion. Miyahra et al. does not teach this limitation. As can be seen in FIG. 1, the sound outlet portion 55 does not mate with the portion 12. Again, rather, the sound outlet port 55 mates with an additional member (not labeled) located in the portion 12, and is completely flanked as material 57 which prevents the port 55 from contacting the portion 12. Such a configuration requires additional assembly materials and steps.

Claim 26 is therefore novel.

Claim 27 and 28 depend from claim 26 and add additional limitations thereto. Claims 27 and 28 are thus novel for the same reasons as discussed above with respect to claim 26.

Additionally, Applicant has added claims 35-38 to clarify certain aspects of Applicant's invention, which claims are similar in many respects to claims 25-26. Applicant believes that claims 35-38 are novel for the same reasons as set forth above with respect to claims 25 and 26.

Applicant therefore submits that the 102(b) rejection of claims 25-28 has been overcome and that these claims, as well as claims 35-38, are allowable.

**Claim 22 is Non-obvious in
View of Miller in Combination with
Gauthier, McCabe and Killion**

Claim 22 presently stands rejected under 35 U.S.C. §103 as being unpatentable over Miller (U.S. Patent No. 3,819,860) in view of Gauthier (U.S. Patent No. 4,520,236), McCabe

(U.S. Patent No. 3,671,685) and further in view of Killion (U.S. Patent No. 4,677,679).

Applicant respectfully submits that claim 22 is non-obvious, for the reasons provided below.

In order for a 35 U.S.C. §103 rejection to be proper, a *prima facie* case of obviousness must be established. *In re Ochiai*, 71 F.3d 1565, 37 U.S.P.Q.2d 1127 (Fed. Cir. 1995), *citing In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The MPEP states:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."

2142 Manual of Patent Examining Procedure, 6th ed., 1st rev. (Sept. 1995) [MPEP], ch. 2100, p. 89.

Applicant submits that a *prima facie* case of obviousness has not been established with respect to claim 22.

With regard to the first criterion, no reason is shown why one of ordinary skill in the art would modify the Miller reference as the Office Action proposes. The Miller reference is not pertinent to the problem of providing a high-fidelity insert earphone addressed by the present invention. Rather, the Miller reference is designed for two-way communication in noisy environments. Moreover, no reason has been shown why it would be obvious to selectively combine the cited references to allegedly produce the claimed combination,

particularly in view of their vastly different designs which address vastly different problems.

Thus, Applicant believes that first criterion has not been met.

With regard to the second criterion, even if the references were combined as set forth in the Office Action, the resulting device has no reasonable expectation of success of achieving Applicant's claimed high fidelity insert earphone. Specifically, one aspect of the acoustic foam material 36 from Gauthier is that it must enable sound to be transmitted through the material 36. The purpose of the liquid in Miller, on the other hand, is to dampen or prevent sound from being transmitted through the liquid. If the acoustic foam material 36 from Gauthier is simply substituted for the body of liquid in Miller, as the Office Action suggests, the resulting device has several factors which would prevent high fidelity reproduction.

First, for example, the resulting device still has the receiver mounted directly on the support body 11, providing direct contact between the end of the receiver and the chamber 36. Vibration from the end of receiver could thus induce noise into the chamber 36 and adversely affect the desired sound transmission therethrough. Second, this problem is compounded by the fact that, since the foam material 36 from Gauthier transmits sound, external noise could penetrate the protective envelope 29, resonate through the substituted foam material 36 to the receiver, which would further induce noise into the chamber 36. Third, the resulting device would still contain two transceivers --a receiver *and* a transmitter. Noise from the transmitter would not only resonate through the substituted foam material to the receiver and be thereby indirectly induced into the chamber 36, but would also be directly induced into the chamber 36 because the receiver and transmitter are mounted on a common surface and because there

simply would be no acoustic seal between the transmitter and the chamber 36. Before any combination as set forth in the Office Action could be made to allegedly achieve Applicant's claimed invention, therefore, Miller must first be modified to remove the transmitter and its sound conducting channel, additional steps not mentioned in the Office Action or suggested by the combination of the references. Thus, Applicant submits that the second criterion has not been met.

With regard to the third criterion, as mentioned above, the resulting device still has the receiver mounted directly on the support body 11, providing direct contact between the end of the receiver and the chamber 36. Consequently, the resulting combination does not teach or suggest the claim limitation of "a ... receiver having a sound outlet port extending partially into the hollow elongated tubular portion of the housing" or the limitation of an insert "assisting to provide an acoustic seal between the hollow body portion and the elongated tubular portion." Thus Applicant submits that the third criterion has also not been met.

Therefore, the rejection utterly fails to establish a *prima facie* case of obviousness. Obviousness simply cannot be established by combining pieces of prior art absent some "teaching, suggestion, or incentive supporting the combination."¹

Where a combination invention can only be arrived at by combining various components described in separate prior art references there must be some reason for the combination; a teaching, a motivation, an incentive, or a suggestion.²

¹ In re Geiger, 815 F.2d 686, 2 U.S.P.Q.2d 1276, 1278 (Fed. Cir. 1987)

² In re Laskowski, 871 F.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398-99 (Fed. Cir. 1989).

The rejection depends upon the improper use of hindsight to re-create the presently claimed combination of ingredients. The invention is not obvious from the prior art itself. One cannot use hindsight reconstruction, picking and choosing among isolated disclosures in the prior art, to deny that the claimed invention is unobvious.³

Claim 22 is therefore non-obvious in view of the cited prior art.

**Claims 23 and 24 Are Unobvious in View of
McCabe in Combination with Langford and Killion**

Claims 23 and 24 presently stand rejected under 35 U.S.C. §103 as being unpatentable over McCabe (U.S. Patent No. 3,671,685) in view of Langford (U.S. Patent No. 3,408,461) and further in view of Killion (U.S. Patent No. 4,677,679). Applicant respectfully submits that claims 23 and 24 are non-obvious, for the reasons provided below.

As mentioned above, in order for a 35 U.S.C. §103 rejection to be proper, a *prima facie* case of obviousness must be established, which requires that three criteria be met. Again, however, a *prima facie* case of obviousness has not been established with respect to claims 23 and 24.

Specifically, in the very least, the third criterion has not been met. The resulting combination does not teach or suggest Applicant's claim limitation of, for example, "a receiver...having a sound outlet port extending partially into the hollow elongated tubular portion of the housing."

³ In re Fine, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

As stated above, obviousness cannot be established by combining pieces of prior art absent some teaching suggestion, or incentive supporting the combination. Applicant again believes the rejection depends upon the improper use of hindsight to re-create the presently claimed combination of ingredients. The invention of claims 23 and 24 are not obvious from the prior art itself. And one cannot use the invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. See *In re Fine*, supra.

Claims 23 and 24 are therefore non-obvious in view of the cited prior art.

**Claims 29-34 Are Unobvious in View of
Miyahra et al. in Combination with Kelsey**

Claims 29-34 presently stand rejected under 35 U.S.C. §103(a) as being unpatentable over Miyahra et al. (U.S. Patent No. 4,447,677) in view of Kelsey (U.S. Patent No. 2,430,229). Applicant respectfully submits that claims 29-34 are non-obvious for the reasons provided below.

As a threshold matter, Applicant points out that claims 29-34 are dependent upon claim 26 and add further limitation to claim 26. Applicant demonstrated above that claim 26 contained limitation(s) not found in the Miyahra et al. reference, and specifically the limitation that the sound outlet port mates with the hollow elongated tubular portion. Since Kelsey similarly lacks the same limitation, the combination likewise lacks that limitation. Thus, the

rejection combining Miyahra et al. and Kelsey in the very least, does not satisfy the third criterion for a *prima facie* case of obviousness with respect to claims 29-34.

Claims 29-34 are therefore non-obvious in view of the cited art.

Conclusion

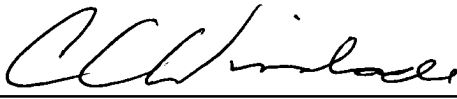
For the foregoing reasons, and the reasons set forth in Applicant's Preliminary Amendment dated December 16, 1997, Applicant believes pending claims 22-38 are in condition for allowance.

If the Examiner disagrees, Applicant respectfully requests that the Examiner telephone the undersigned at (312) 707-8889.

Notice of Allowability is courteously solicited.

Respectfully submitted,

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